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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,616	01/22/2002	Kazuhiro Sato	Q68109	6802

23373 7590 11/19/2003
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037

EXAMINER

JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
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-1773

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

10/031,616

Applicant(s)

SATO ET AL.

Examiner

Monique R Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

1. The amendment filed 9/3/03 has been entered. Claims 1-8 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07-195617 in view of Nakamaki et al (USPN 6,099,924) or Kosuge et al (USPN 6,071,599) for the reasons recited in the prior office action and restated below.
4. JP 07-195617 teaches a resin-coated metal sheet and a metal can or closure obtained therefrom such that the resin coating is on the inner surface of the can. The resin coating composition comprises a 75-99wt pts of a polyethylene terephthalate copolyester and 1-25wt pts of a dispersed ethylene ionomer resin wherein the seed metal is Na or Zn and the resin coating composition may further comprises conventional additives (Abstract; 0003; 0014; 0020-0022; 0033; 0034-0042.) JP'617 does not teach that the coating further comprises tocopherol, a conventional antioxidant, in the amount as instantly recited. However, JP'617 does teach that conventional additives may be utilized in the coating wherein Kosuge et al and Nakamaki et al teach that antioxidants are conventional additives utilized in polyester metal coating compositions and further that teach that tocopherol is an obvious species of antioxidant utilized in the art (Kosuge, Col. 9, lines 15-30; Nakamaki, Col. 15, lines 1-2.) Further Nakamaki teaches that the antioxidant may be contained in an amount of 0.01 to 1.5 parts by weight per 100 parts of the polyester or polyester composition (Col. 15, lines 1-5) and similarly, Kosuge et al teach that the antioxidant is preferably contained in an amount of 0.01 to 5wt% wherein when the

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proportion is less than 0.01wt%, the effect of the antioxidant added is hardly observed while when the proportion is more than 5wt%, further effect of the antioxidant is hardly obtained (Col. 9, lines 51-56.) Hence, one having ordinary skill in the art at the time of the invention would have been motivated to include a conventional antioxidant, such as tocopherol, in the polyester coating composition taught by JP'617 utilizing routine experimentation to determine the optimum amount of antioxidant to provide the desired antioxidant properties as taught by Kosuge et al or utilizing an amount of from 0.01 to 1.5 wt parts as taught by Nakamaki. Further, with regards to instant claims 3 and 5, though JP'617 do not teach the melt viscosity of the resin layer, the inherent viscosity of the polyester, which is an indication of molecular weight, and the particle size of the ionomer resin present as dispersed particles in the polyester, these properties are known result-effective variables affecting the coating properties of the composition and one having ordinary skill in the art at the time of the invention would have been motivated to determine the suitable operating range for these properties to provide the necessary coating properties for a particular coating method.

Response to Arguments

5. Applicant's arguments filed 9/3/03 have been fully considered but they are not persuasive. The Applicant argues that the polyester of the secondary references teach the use of tocopherol as an antioxidant is different from the polyester of the primary reference JP'617 and hence it would not have been obvious to one skilled in the art to utilize tocopherol in the invention taught by JP'617. However, the Examiner notes that JP'617 teaches that conventional additives can be utilized in the polyester composition wherein the Examiner takes the position that an antioxidant is a conventional additive and that the secondary references, as well as the

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Applicant's own admission, teach that tocopherol is a known antioxidant. Hence, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant case, JP'617 teaches conventional additives wherein antioxidants are conventional polyester additives and tocopherol is a known antioxidant utilized in polyester compositions, hence, providing a suggestion to one skilled in the art to utilize tocopherol in the invention taught by JP'617. The Applicant further argues that the combined references do not teach or suggest the alleged improved properties, however, the Examiner notes that there is no clear showing of unexpected results on the record with respect to the instantly claimed weight percentage of tocopherol. Further, with regards to the melt viscosity and particle size, the Examiner maintains her position that these properties are result-effective variables wherein the results presented in Comparative Examples 7 and 8 are insufficient in providing a showing of unexpected results with regards to the closest prior art in order to overcome the obviousness rejections. However, the Examiner may reconsider her position upon a clear showing of unexpected results with regards to the tocopherol amount, the melt viscosity and the particle size.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Monique R. Jackson
Patent Examiner
Technology Center 1700
November 12, 2003